

REMARKS

Claim 12 has been canceled, without prejudice, and therefore claims 11, and 13 to 20 are now pending.

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to paragraph one (1) of the Office Action, while the objections may not be agreed with, to facilitate matters, claim 12 has been cancelled, and claims 18 and 19 have been rewritten to better clarify or define the subject matter. Withdrawal of the objections is therefore respectfully requested.

With respect to paragraph two-point-one (2.1) of the Office Action, claims 11, 13, 14, 15, 17, 18, and 20 were rejected under 35 U.S.C. § 102(b) as anticipated by Watanabe, Japanese Patent No. JP-60101958.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claims 11 and 17 have been rewritten to provide that the phase terminal is arranged identically to one of the positive terminal or the negative terminal.

As to the “Watanabe” reference, Figures 2 through 8 only refer to a positive terminal, a negative terminal, a phase terminal, and two semiconductor chips. This arrangement wholly differs from the presently claimed subject matter since the phase terminal is not arranged identically to one of the positive terminal or the negative terminal. Therefore, “Watanabe” does not identically disclose (or even suggest) that the phase terminal is arranged identically to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claims 11 and 17, as presented.

Accordingly, these claims and the dependent claims 13, 14, and 15 are allowable.

While the rejections may not be agreed with, to facilitate matters, claim 18 has been rewritten to provide that the phase terminal is situated rotated by 180° about the terminal axis of the terminal lug in relation to one of the positive terminal or the negative terminal.

As to the “Watanabe” reference, Figures 2 through 8 only indicate a phase terminal stacked together with a positive terminal, a negative terminal, and two semiconductor chips. Nowhere does “Watanabe” disclose that the phase terminal is situated rotated 180° about the terminal axis of the terminal lug. Therefore, “Watanabe” does not identically disclose (or even suggest) that the phase terminal is situatedly rotated by 180° about the terminal axis of the terminal lug in relation to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claim 18, as presented.

Accordingly, claim 18 and its dependent claim 20 are allowable.

Accordingly, as presented, claims 11, 13, 14, 15, 17, 18 and 20 are allowable. It is therefore respectfully requested that the anticipation rejections be withdrawn.

With respect to paragraph two-point-two (2.2) of the Office Action, claims 11, 16, 17, 18, and 19 were rejected under 35 U.S.C. § 102(e) as anticipated by Spitz et al., U.S. Patent No. 6,774,476.

While the rejections may not be agreed with, to facilitate matters, claims 11 and 17 have been rewritten to provide that the phase terminal is arranged identically to one of the positive terminal or the negative terminal.

As to the "Spitz" reference, Figures 2 through 7 only indicate two mounting plates, an electrically conductive insert, and semiconductor substrates. This arrangement wholly differs from the presently claimed subject matter since the phase terminal is not arranged identically to one of the positive terminal or the negative terminal. Therefore, "Spitz" does not identically disclose (or even suggest) that the phase terminal is shaped identically to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claims 11 and 17, as presented.

Accordingly, these claims and the dependent claim 16 are allowable.

While the rejections may not be agreed with, to facilitate matters, claim 18 has been rewritten to provide that the phase terminal is situated rotated by 180° about the terminal axis of the terminal lug in relation to one of the positive terminal or the negative terminal.

As to the "Spitz" reference, Figures 2 through 7 only refer to an electrically conductive insert stacked together with two mounting plates, and semiconductor substrates. Nowhere does "Spitz" identically disclose (or suggest) that the phase terminal is situatedly rotated 180° about the terminal axis of the terminal lug. Therefore, "Spitz" does not identically disclose (or even suggest) the feature in which the phase terminal is situatedly rotated by 180° about the terminal axis of the terminal lug in relation to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claim 18.

Accordingly, claim 18 and its dependent claim 19 are allowable.

Accordingly, as presented, claims 11, 16, 17, 18, and 19 are allowable. It is therefore respectfully requested that the anticipation rejections be withdrawn.

With respect to paragraph three-point-one (3.1), claims 12, 16, and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Watanabe” reference in view of Irmmler, Patent No. WO-7900814.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 12 has been canceled, without prejudice.

Claim 16 depends from claim 11, as presented, and is therefore allowable for the same reasons as claim 11, as presented, since the secondary “Irmmler” reference does not cure – and is not asserted to cure -- the critical deficiencies of the principal reference. As to the “Irmmler” reference, Figure 1 only indicates three metal washers having different diameters. Therefore, “Irmmler” does not identically disclose, or even suggest, that the phase terminal is arranged identically to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claim 11, as presented.

Claim 19 depends from claim 18, as presented, and is therefore allowable for the same reasons as claim 18, as presented, since the secondary “Irmmler” reference does not cure – and is not asserted to cure -- the critical deficiencies of the principal reference. As to the “Irmmler” reference, Figures 1 and 4 do not identically disclose (or even suggest) that the phase terminal is situatedly rotated by 180° about the terminal axis of the terminal lug in relation to one of the positive terminal or the negative terminal, as provided for in the context of the presently claimed subject matter of claim 18, as presented.

Accordingly, claims 16 and 19 are allowable.

Conclusion

It is therefore respectfully submitted that each of claims 11 and 13 to 20 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

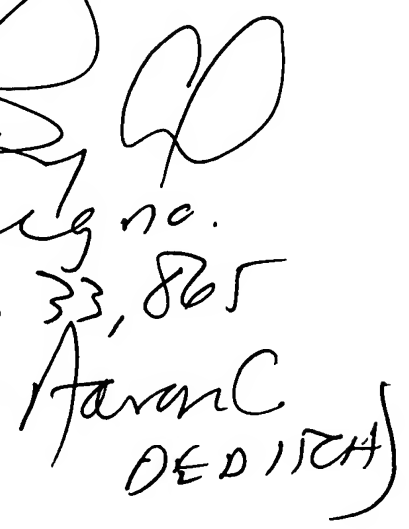
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